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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,739	03/07/2002	Klaus Knoerr	ADI-082	7325
21323	7590	03/31/2004	EXAMINER	
TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110			NAKARANI, DHIRAJLAL S	
			ART UNIT	PAPER NUMBER
			1773	
DATE MAILED: 03/31/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/092,739	<b>Applicant(s)</b> KNOERR, KLAUS	
	<b>Examiner</b> D. S. Nakarani	<b>Art Unit</b> 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. The disclosure is objected to because of the following informalities: Page 8, line 1, the phrase "di-comyl-peroxide" should read - - di-cumyl-peroxide - -. Applicant is requested to review entire specification for additional error.

Appropriate correction is required.

2. Applicant's election without traverse of Group II in Paper filed December 15, 2003 is acknowledged.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ritter (U.S. Patent 6,061,929) for the reasons of record set fourth in paragraph 10 of the Office Action mailed July 7, 2003.

In addition, the added limitation "and shaped to assume a predetermined final outer contour by co-vulcanization" is met by Ritter's disclosure at col. 4, lines 61-67 and col. 5, lines 1-12. Further, this limitation is a process-step. It is the patentability of the product claimed and NOT of the recited process step, which must be established.

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product – by – process claim, the burden is on the applicant to present evidence from which the Examiner could

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reasonably conclude that the claimed product differs in kind from those of the prior art. (In re Brown, 459 F. 2d 531, 173 U.S.P.Q. 685 (C.C.P.A. 1972); In re Fessman 489F. 2d 742; 180 U.S.P.Q 324 (C.C.P.A. 1974). This burden is not discharged solely because the product was derived from a process not known to the prior art.

When the prior art discloses a product, which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. PTO is not equipped to make and then compare products (In re Brown, 459 F. 2d, 531, 193 USPQ 68SC.C.P.A.1972).

5. Claims 10-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter (U.S. Patent 6,061,929) in view of Tanuma et al (U.S. Patent 4,511,627) for the reasons of record set forth in paragraph 11 of the Office Action mailed July 7, 2003 and in addition, added reasons above in paragraph 4 for the added limitation "and shaped to assume a predetermined final outer contour by co-vulcanization".

6. Applicant's arguments filed December 15, 2003 have been fully considered but they are not persuasive. In reference to rejection of claims under 35 USC 102 (b) as being anticipated by Ritter (U.S. Patent 6,061,929) and in reference to rejection of claims under 35 USC 103(a) as being unpatentable over Ritter (U.S. Patent 6,061,929) in view of Tanuma et al (U.S. Patent 4,511,627), applicant mainly argue referring to add

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limitation "attached and shaped to assume a predetermine final outer contour by co-vulcanization". Neither Ritter nor Tanuma et al teach or suggest this limitation.

These argument are unpersuasive because Ritter teaches bonding two disclosed parts by heat and pressure causing chemical cross linking to occur between two disclosed parts namely shank piece and sole piece along mating side surfaces. Ritter also teaches hot compression molding step to impart desired treads to the bottom of the sole and a suitable upper surface for contact with the user's foot. Thus hot compression molding process step imparts predetermined shape. There is no evidence provided showing that predetermined claimed shape cannot be achieved by Ritter's disclosed process step. Also there is nothing on record showing that the claimed final product is different than the final product of the prior art.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau, can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. S. Nakarani  
Primary Examiner  
Art Unit 1773

D. S. Nakarani/af  
March 23, 2004